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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

PATENT APPLICATION

ATTORNEY DOCKET NO. 10010609 -1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Robert Sesek et al.

Confirmation No.: 2504

Application No.: 09/938893

Examiner: Safaipour Houshang

Filing Date: Aug 24, 2001

Group Art Unit: 2625

Title: Optical Scanning Device Having Selectable, Identifiable Scan Window

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

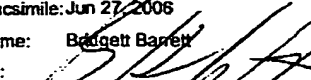
**TRANSMITTAL LETTER FOR PETITION UNDER C.F.R. § 1.181 FOR REFUND OF
EXTENSION OF TIME FEE UNDER 37 C.F.R. § 1.136(a)**

This petition for refund is submitted under CFR §1.181 for Refund of Extension of Time Fee under 37 CFR § 1.136(a).

[X] Please charge to Deposit Account 08-2025 the sum of \$130.00, the petition fee set forth in § 1.17(h). At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

☐ I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450
Date of Deposit:

OR

☒ I hereby certify that this paper is being transmitted to the Patent and Trademark Office facsimile number (571) 273-8300.
Date of facsimile: Jun 27, 2006
Typed Name: Bridgett Barrett
Signature: 

Rev 10/05 (Refund)

Respectfully submitted,

Robert Sesek et al.

By 

Gregg W. Wisdom

Attorney/Agent for Applicant(s)

Reg No. : 40,231

Date : Jun 27, 2006

Telephone : 360 212 8052

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**PATENT APPLICATION
DOCKET NO. 10010609-1**

**IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE**

INVENTOR(S): Robert Sesek et al **CONFIRMATION NO.:**
SERIAL NO. 09/938,893 **GROUP ART UNIT:** 2625
FILED: 08/24/2001 **EXAMINER:** Houshang Safaipoor
SUBJECT: OPTICAL SCANNING DEVICE HAVING SELECTABLE,
IDENTIFIABLE SCAN WINDOW

**MAIL STOP PETITION
THE ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231**

SIR:

**PETITION UNDER C.F.R. § 1.181 FOR REFUND OF EXTENSION OF TIME
FEE UNDER 37 C.F.R. § 1.136(a)**

In response to the advisory action mailed on June 1, 2006, the Applicant respectfully requests consideration of the following petition requesting refund of an extension of time fee.

It is not believed that fees are required beyond those that may be otherwise provided for in documents accompanying this paper. However, in the event that additional fees are necessary to allow consideration of this petition, such fees are hereby authorized to be charged to Deposit Account No. 08-2025.

Remarks begin on page 2 of this response.

Remarks

Statement of Facts

As can be seen from the attached copy of the advisory action labeled "Exhibit A" mailed June 1, 2006, the Examiner checked box 1a) indicating that "The period for reply expires 3 months from the mailing date of the final rejection." The Applicants respectfully submit that box 1a) was improperly checked by the Examiner. As can be seen from the attached copy of the final rejection labeled "Exhibit B", the mailing date of the final rejection was January 30, 2006, resulting in a date of 2 months from the mailing of the final rejection as March 30, 2006. The response to the final rejection was mailed within 2 months of the mailing date of the final rejection. In support of this, please see the attached copy of the response to the final rejection labeled "Exhibit C" including the certificate of mailing establishing a mailing date of the response to the final rejection of March 23, 2006. Furthermore, please see the attached copy of the USPTO receipt for the response to the final rejection establishing a mailing date of the response to the final rejection of March 23, 2006 labeled as Exhibit D.

Points to be Reviewed

According to MPEP 706.07(f)(A), "if the reply is filed within 2 months of the date of the final Office action, the shortened statutory period will expire at 3 months from the date of the final rejection or on the date the advisory action is mailed, whichever is later". Furthermore, according to MPEP 706.07(f)(E), "If the examiner, however, does not mail an advisory action until after the end of the 3-month period, the shortened statutory period will expire on the date the examiner mails the advisory action and any extension of time fee would be calculated from the mailing date of the advisory action". Therefore, because the response to the final rejection was filed within 2 months of the date of the mailing of the final rejection and because the advisory action was mailed after April 30, 2006 (the date 3 months from the mailing date of the final rejection) the Applicants respectfully submit that the shortened statutory period for reply should have

HP Docket Number 10010609-1

2

SN 09/938,893
Petition

expired on June 1, 2006, the mailing date of the advisory action. Accordingly, the Examiner was required to check box 1b) of the advisory action as indicated by MPEP 706.07 (f).

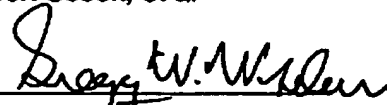
Action Requested

On June 9, 2006, the Applicants filed a Request for Continued Examination under 37 C.F.R. 1.114 authorizing payment of a 2 month extension of time fee because box 1a) was checked by the Examiner in the advisory action even though payment of a 1 month extension of time fee was proper. This was done to avoid the risk incurring the additional expense of an extension of time fee beyond 1 month while waiting for the Examiner to issue a corrected advisory action and to advance prosecution in a timely manner. The Applicants hereby petition for refund to Deposit Account No. 08-2025 an amount of money equal to the difference between the 2 month extension of time fee charged to this deposit account for this application and the 1 month extension of time fee that should have been charged to this deposit account.

Respectfully submitted,

Robert Seseek, et al

By



Gregg W. Wisdom

Reg. No. 40,231

June 26, 2006

(360) 212-8052

Exhibit A



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 UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
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HP LEGAL

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,893 ✓	08/24/2001 ✓	Robert Sesck	10010609-1 ✓	2504 ✓
<div style="display: flex; justify-content: space-between;"> <div> 7590 HEWLETT-PACKARD COMPANY Intellectual Property Administration P.O. Box 272400 Fort Collins, CO 80527-2400 </div> <div> EXAMINER SAFAIPOUR, HOUSHANG </div> </div>				
		<div style="display: flex; justify-content: space-between;"> <div>ART UNIT</div> <div>PAPER NUMBER</div> </div>		
		2625		

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

JUN 27 2006

Exhibit A

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/938,893 ✓	Applicant(s) SESEK ET AL.	
	Examiner Houshang Safaipoor	Art Unit 2625	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 March 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

a) ☒ The period for reply expires 2 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because

(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);

(b) ☐ They raise the issue of new matter (see NOTE below);

(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: _____

Claim(s) withdrawn from consideration: _____

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____

JEROME GRANT
PRIMARY EXAMINER

U.S. Patent and Trademark Office
PTOL-303 (Rev. 7-05)

Advisory Action Before the Filing of an Appeal Brief

Part of Paper No. 20060527

Exhibit A

Continuation Sheet (PTO-303)

Application No. 09/938,893

Continuation of 3. NOTE: the amended claim 1 ^{of recites} ~~recites~~ ^{least} ~~that~~ "at least one of the plurality of moveable position markers includes a light source on the at least one of the plurality of markers configured to direct light into at least one of the sides of the member" requires further consideration and search. 1

JW

Exhibit B

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,893 ✓	08/24/2001 ✓	Robert Sasek	10010609-1 ✓	2504 ✓
<div style="display: flex; justify-content: space-between;"> <div> <p>7590 01/30/2006</p> <p>HEWLETT-PACKARD COMPANY Intellectual Property Administration P.O. Box 272400 Fort Collins, CO 80527-2400</p> </div> <div> <p>EXAMINER SAFAIPOUR, HOUSHANG</p> </div> </div>				
			ART UNIT	PAPER NUMBER
			2627	

DATE MAILED: 01/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Exhibit B

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JUN 27 2006

Office Action Summary	Application No.	Applicant(s)	
	09/938,893	SESEK ET AL	
	Examiner	Art Unit	
	Houshang Safaipoor	2627	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 07 November 2005.

2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1,2,7-13,15-21,26 and 27 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1,2,7-10,13,15-18,21,26 and 27 is/are rejected.

7) ☒ Claim(s) 11,12,19 and 20 is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

U.S. Patent and Trademark Office
PTOL-326 (Rev. 7-05)

Office Action Summary

Part of Paper No./Mail Date 20080120

Exhibit B

Application/Control Number: 09/938,893
Art Unit: 2627

Page 2

DETAILED ACTION

Response to Amendment

Applicant's amendment filed on November 7, 2005 has been entered and made of record.

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The underlined portion of the following limitation of claim 1 is vague and indefinite:

"a scan window illumination device including a plurality of light sources with individual of the plurality of moveable position markers including a one of the plurality of the light sources and with the plurality of the light sources configured to direct light into the first side and the second side.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Exhibit B

Application/Control Number: 09/938,893
Art Unit: 2627

Page 3

Claims 1, 2, 7-10, 13, 15, 16-18, 21, 26, 27 are rejected under 35 U.S.C. 102(b) as being unpatentable over Kurata et al. (U.S. Patent No. 4,518,999).

Regarding claim 1, Kurata et al. discloses a scan window apparatus for indicating a scan window within a member of a scanning device, the member having a first side and a second side intersecting the first side (fig. 1) comprising:

a scan window definition device including a plurality of moveable position markers (cursors 3, 4, 5 and 6) configured to move along the first side and the second side of the member (fig. 1, col. 1, lines 30-41); and

Kurata discloses that the cursors (position markers) 3, 4, 5 and 6 are used in a conventional picture image position setting apparatus in which a desired region of an original document can be **directly designated on a platen** (col. 1, lines 23-25). Kurata uses cursors, in different configuration, in his "Picture Image Position setting Apparatus" for designating desired region of an original on the platen. Kurata further discloses that a light emitting element such as a light emission diode may be provided at the cursors. Therefore it would have been obvious to a person of an ordinary skill in the art to provide light emission diode at cursors 3, 4, 5 and 6 of a conventional position setting apparatus to identify a desired region (scanning window) on platen 2 as shown on figure 1.

Regarding claim 2, Kurata discloses the scan window apparatus of claim 1, and wherein the member comprises an essentially transparent platen defined by a first surface on which an object to be scanned can be placed, and an opposite second surface (fig. 1).

Regarding claim 7, Kurata discloses the scan window apparatus of claim 1, wherein:
the member includes a transparent platen having a top surface and a bottom surface; and

Exhibit B

Application/Control Number: 09/938,893
Art Unit: 2627

Page 4

the plurality of the light sources are located proximate to the first side and the second side to allow the light to enter the platen between the top surface and the bottom surfaces (fig. 1 and please refer to the detailed explanation under claim 1).

Regarding claims 8, 9, 13, 15, 16-18, 21, and 27, arguments analogous to those presented for claim 1 are applicable to claims 8, 9, 13, 15, 16-18, 21 and 27.

Regarding claims 10, Kurata discloses the scan window apparatus of claim 9, wherein the scan window definition device comprises a plurality of moveable position markers configured to move along the first edge and the second edge of the scanable surface and thereby define the scan window, the scan window apparatus further comprising a plurality of position detectors configured to detect the positions of the plurality of position markers along the first and second edges of the scanable surface and to generate position signals in response thereto, and wherein the apparatus is configured to use at least one of the position signals to direct the focused beam of light (fig. 1, col. 1, lines 42-51 and also the discussion under claim 1).

Regarding claim 26, arguments analogous to those presented for claim 10 are applicable to claim 26.

Allowable Subject Matter

Claims 11, 12, 19, and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Application/Control Number: 09/938,893
Art Unit: 2627

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conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Houshang Safaipoor whose telephone number is (571)272-7412. The examiner can normally be reached on Mon.-Thurs. from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles, Sr. can be reached on (571)272-7402. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

Exhibit B

Application/Control Number: 09/938,893
Art Unit: 2627

Page 6

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Houshang Safaipoor
Patent Examiner
Art Unit 2622
January 20, 2006

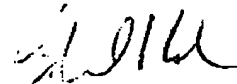


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Notice of References Cited	Application/Control No. 09/938,893	Applicant(s)/Patent Under Reexamination SESEK ET AL.	
	Examiner Houshang Safalpour	Art Unit 2627	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-4,518,989	05-1985	Kurata et al.	358/488
	B	US-			
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Data, Publisher, Edition or Volume, Pertinent Page(s)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

U.S. Patent and Trademark Office
PTO-882 (Rev. 01-2001)

Notice of References Cited

Part of Paper No. 20060120

Exhibit C

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HEWLETT-PACKARD COMPANY
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Fort Collins, Colorado 80527-2400

PATENT APPLICATION

ATTORNEY DOCKET NO. 10010609-1

Inventor(s): Robert Sesek, et al.

Confirmation No.: 2504

Application No.: 09/938,893

Examiner: Houshang Safalpour

Filing Date: 08/24/2001

Group Art Unit: 2627

Title: OPTICAL SCANNING DEVICE HAVING SELECTABLE, IDENTIFIABLE SCAN WINDOW

Mail Stop After Final
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Transmitted herewith is/are the following in the above-identified application:

- ☒ Response/Amendment
☐ New fee as calculated below
☒ No additional fee
☐ Other

- ☐ Petition to extend time to respond
☐ Supplemental Declaration

Fee\$

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS		MINUS		= 0	X \$50	\$ 0
INDEP. CLAIMS		MINUS		= 0	X \$200	\$ 0
<input type="checkbox"/> FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ \$360	\$ 0
EXTENSION FEE	<input type="checkbox"/> 1st Month \$120	<input type="checkbox"/> 2nd Month \$450	<input type="checkbox"/> 3rd Month \$1020	<input type="checkbox"/> 4th Month \$1590		\$ 0
OTHER FEES						\$
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 0

Charge \$ 0 to Deposit Account 08-2025. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450.

Date of Deposit: 03/23/2006

Typed Name: Sarah L. Reinhard

Signature: 

Respectfully submitted,

Robert Sesek, et al.

By 

Jeffrey L. Cameron

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Reg No. : 43,527

Date : 03/23/2006

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Rev 10/05 (TransAm)

Exhibit C

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

PATENT APPLICATION

ATTORNEY DOCKET NO. 10010609-1

Inventor(s): Robert Sesek, et al.
Application No.: 09/938,893
Filing Date: 08/24/2001

Confirmation No.: 2504
Examiner: Houshang Safalpour
Group Art Unit: 2627

Title: OPTICAL SCANNING DEVICE HAVING SELECTABLE, IDENTIFIABLE SCAN WINDOW

Mail Stop After Final
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Transmitted herewith is/are the following in the above-identified application:

- ☒ Response/Amendment
☐ New fee as calculated below
☒ No additional fee
☐ Other

- ☐ Petition to extend time to respond
☐ Supplemental Declaration

Fee\$

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS		MINUS		= 0	X \$50	\$ 0
INDEP. CLAIMS		MINUS		= 0	X \$200	\$ 0
<input type="checkbox"/> FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM + \$360						\$ 0
EXTENSION FEE	<input type="checkbox"/> 1st Month \$120	<input type="checkbox"/> 2nd Month \$450	<input type="checkbox"/> 3rd Month \$1020	<input type="checkbox"/> 4th Month \$1590		\$ 0
OTHER FEES						\$
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 0

Charge \$ 0 to Deposit Account 08-2025. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450.

Date of Deposit: 03/23/2006

Typed Name: Sarah L. Reinhard

Signature: 

Respectfully submitted,

Robert Sesek, et al.

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Application No. : 09/938,893 Confirmation No.: 2504
Applicant: : Robert Sesek, et al.
Filed: : August 24, 2001
TC/A.U. : 2627
Examiner: : Houshang Safaipour

Docket: : 10010609-1
Customer No.: : 022879

MS AF
Commissioner for Patents
P.O. BOX 1450
Alexandria, VA 22313-1450

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.116

Dear Examiner Safaipour:

In response to the Final Office Action of January 30, 2006, please amend the above-identified application as follows:

Amendments to the Claims are reflected in the listing of claims which begins on page 2 of this paper.

Remarks/Arguments begin on page 7 of this paper.

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Amendments to the Claims:

This listing of claims will replace all prior versions, and listings, of claims in the application:

Listing of Claims:

1. (Currently Amended) A scan window apparatus for indicating a scan window within a member of a scanning device, the member having a first side and a second side intersecting the first side, comprising:

a scan window definition device including a plurality of moveable position markers configured to move along the first side and the second side of the member; and

a scan window illumination device, ~~wherein at least one including a plurality of light sources with individual~~ of the plurality of moveable position markers ~~includes including a one of the plurality of the a light sources source on the at least one of the plurality of markers and with the plurality of the light sources~~ configured to direct light into the first side and the second side at least one of the sides of the member.

2. (Previously Presented) The scan window apparatus of claim 1, and wherein the member comprises an essentially transparent platen defined by a first surface on which an object to be scanned can be placed, and an opposite second surface.

3. (Canceled)

4. (Canceled)

5. (Canceled)

6. (Canceled)

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7. (Currently Amended) The scan window apparatus of claim 1, wherein:
the member includes a transparent platen having a top surface and a bottom surface; and
~~the plurality of the light sources configured to direct light into at least one of the sides of the member~~ are located proximate to the first side and the second side to allow the light to enter the platen between the top surface and the bottom surface.
8. (Currently Amended) The scan window apparatus of claim 7, wherein the platen is impregnated with light reflective particles oriented to reflect light from the ~~light sources configured to direct light into at least one of the sides of the member~~ ~~plurality of the light sources~~, but to allow the light from a scanning light source to freely pass through the platen from the bottom surface to the top surface.
9. (Previously Presented) A scan window apparatus for indicating a scan window within a scanable surface of a scanning device, the scanable surface having a first edge and a second edge intersecting the first edge, comprising:
a scan window definition device to allow a user to define the scan window on the scanable surface; and
a scan window illumination device including a light source configured to generate a focused beam of light to trace at least part of a perimeter of the scan window.
10. (Previously Presented) The scan window apparatus of claim 9, wherein the scan window definition device comprises a plurality of moveable position markers configured to move along the first edge and the second edge of the scanable surface and thereby define the scan window, the scan window apparatus further comprising a plurality of position detectors configured to detect the positions of the plurality of position markers along the first and second edges of the scanable surface and to generate position signals in response thereto, and wherein the scan window apparatus is configured to use at least one of the position signals to direct the focused beam of light.

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11. (Previously Presented) The scan window apparatus of claim 9, further comprising an oscillating mirror, wherein the focused beam of light is generated by a laser and is directed by the oscillating mirror to trace at least a part of the perimeter.

12. (Previously Presented) The scan window apparatus of claim 9, further comprising a rotating polygonal-sided mirror, wherein the focused beam of light is generated by a laser and is directed by the rotating polygonal-sided mirror to trace at least a part of the perimeter.

13. (Previously Presented) An optical scanning device comprising:
a platen defining a scanable surface, the platen comprising an essentially transparent surface defined by an upper side and a lower side, the scanable surface being defined by a first edge and a second edge orthogonal to the first edge;
a scanning light source configured to optically scan an object placed proximate the upper side of the platen, the scanning light source being located proximate the lower side of the platen;
a scan window definition device to allow a user to define a scan window on the platen to be scanned by the scanning light source; and
a scan window illumination device configured to define the scan window with a perimeter, the scan window illumination device comprising a light source configured to generate a focused beam of light to trace at least part of the perimeter.

14. (Canceled)

15. (Previously Presented) The optical scanning device of claim 13, wherein the scan window definition device includes the scan window illumination device and is configured to direct the focused beam of light.

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16. (Previously Presented) The optical scanning device of claim 13, further comprising a back-lighting light source positioned to direct light to the lower side of the platen.

17. (Previously Presented) The optical scanning device of claim 15, and wherein the scan window definition device comprises a plurality of moveable position markers configured to move along the first and second edges of the scanable surface and thereby define the scan window.

18. (Previously Presented) The optical scanning device of claim 15, and wherein the scan window definition device comprises a user interface allowing a user to identify positions along the first edge and the second edge of the scanable surface to thereby define the scan window.

19. (Currently Amended) The optical scanning device of claim 13 [[14]], further comprising an oscillating mirror, wherein the focused beam of light is generated by a laser and wherein the oscillating mirror is configured to direct the focused beam of light to trace at least a part of the perimeter.

20. (Currently Amended) The optical scanning device of claim 13 [[14]], further comprising a rotating polygonal-sided mirror, wherein the light source comprises a laser, and wherein the rotating polygonal-sided mirror includes a configuration to direct the focused beam of light to trace at least a part of the perimeter.

21. (Previously Presented) A method of identifying a scan window to be scanned as part of a scanable surface, comprising:
defining the scan window; and
tracing at least a portion of a perimeter of the scan window on the scanable surface using at least one focused beam of light.

22. (Canceled)

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23. (Canceled)

24. (Canceled)

25. (Canceled)

26. (Previously Presented) The method of claim 21, and further comprising generating signals to define the portion of the perimeter for the tracing, and; using the signals to direct the focused beam of light.

27. (Previously Presented) The method of claim 26, further comprising scanning only the scan window on the scanable surface.

28. (Canceled)

29. (Canceled)

30. (Canceled)

31. (Canceled)

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REMARKS/ARGUMENTS

Applicant has carefully reviewed and considered the Final Office Action mailed on January 30, 2006, and the references cited therewith.

Claims 1, 7-8, and 19-20 are amended, and claims 3-6, 14, 22-25, and 28-31 were previously canceled; as a result, claims 1, 2, 7-13, 15-21, and 26-27 are now pending in this application.

§ 112 Rejection of the Claims

Claim 1 was rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Applicant has amended claim 1 in order to more clearly define and recite the subject matter therein. Applicant respectfully submits that claim 1 is now in accordance with 35 USC § 112. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the § 112 rejection.

§ 103 Rejection of the Claims

Claims 1, 2, 7-10, 13, 15, 16-18, 21, 26, and 27 were rejected under 35 USC § 103(a) as being unpatentable over Kurata et al (U.S. Patent No. 4,518,999). Applicant respectfully traverses the rejection as set forth below.

Independent Claim 1

As mentioned above, Applicant has amended independent claim 1 to particularly point out and distinctly claim the subject matter therein in accordance with § 112.

With respect to the § 103(a) rejection of claim 1, the Examiner cites column 1, lines 23-25 of the Kurata reference as disclosing cursors of an imaging apparatus used to designate a region on a platen. In column 1, lines 23-25, the Kurata reference states, "Fig. 1 shows a conventional picture image position setting apparatus in which a desired region of an original document can be directly

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designated on a platen." At column 1, lines 30-33 and lines 42-51, the Kurata reference states:

The . . . apparatus is provided with cursors 3, 4, 5, and 6 . . . for performing positioning operations in the X and Y directions. . . . When the X-direction cursors 3 and 4 are moved . . . detector elements . . . move following the cursors 3 and 4 to be properly positioned at the starting and end points . . . to provide these starting and end points as inputs to the system. . . .

By stating this, the Kurata reference appears to describe a conventional imaging apparatus in which the physical location of cursors may be detected to determine the point at which a reading element passes the cursors.

Furthermore, Kurata discloses that in conventional imaging systems voltages corresponding to the starting and end positions in the Y-direction can result in poor accuracy due to the use of a slide resistor. (column 1, lines 52-67). At column 2, lines 27 -30, the Kurata reference appears to describe a conventional imaging system that seeks to overcome this poor accuracy by providing a system in which "A circuit is provided for converting picture image information with respect to the position designating cursor which has been read into positional information in the main scanning direction." (column 2, lines 27-30). The Kurata reference does not describe, teach, or suggest "a scan window illumination device, wherein at least one of the plurality of moveable position markers includes a light source on the at least one of the plurality of markers and configured to direct light into at least one of the sides of the member," as recited in Applicant's independent claim 1, as amended.

The Examiner also states, "Kurata further discloses that a light emitting element such as a light emission diode may be provided at the cursors. Therefore, it would have been obvious . . . to provide light emission diodes at cursors 3, 4, 5, and 6 of a conventional position setting apparatus to identify a desired region (scanning window) on platen 2 as shown in figure 1. (Office Action, page 3, paragraph 4).

However, at column 4, line 65 to column 5, line 2, Kurata states, "Furthermore, although fluorescent lamps are used for directing light onto the cursor to detect the position thereof, a light emitting element such as a light emission diode may be provided at the cursor to detect the position thereof without using any fluorescent lamp." By stating this, the Kurata reference appears to disclose using a light emission diode to direct light onto the cursor in order to detect the physical

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position of the cursor, as an alternative to using the fluorescent lamps to direct light onto the cursor to detect the physical position thereof. Applicant respectfully submits that "at" is not equivalent to "on."

The Kurata reference does not describe, teach, or suggest "a scan window illumination device, wherein at least one of the plurality of moveable position markers includes a light source on the at least one of the plurality of markers and configured to direct light into at least one of the sides of the member," as provided in Applicant's independent claim 1, as amended. Support for this claim language can be found in Applicant's specification at page 15, lines 11-12 and Figure 4.

Applicant notes that the Examiner has only cited a single reference in support of the 103 rejection of all claims in the present application. Applicant submits that the description in Kurata is insufficient to describe, teach, or suggest the claims of the present application because each and every element and limitation is not explicitly or implicitly stated, unless combined with another reference or the Examiner's personal knowledge. In such case, Applicant respectfully requests that the Examiner provide a specific document or an affidavit to support an obviousness rejection.

As such, each and every element of independent claim 1, as amended, is not described, taught, or suggested in the Kurata reference. Accordingly, reconsideration and withdrawal of the § 103 rejection for the above independent claim 1, as well as those claims which depend therefrom, is respectfully requested.

Independent Claims 9, 13, and 21

The Examiner states on page 4 of the office action that arguments analogous to those presented for claim 1 are applicable to independent claims 9, 13, and 21. However, with respect to claims 9, 13, and 21, Applicant is unable to locate an indication from the Examiner as to where, in the Kurata reference, a description, teaching, or suggestion of using a focused beam of light to trace at least a portion of a scan window perimeter exists.

Applicant respectfully submits that the Examiner has not established a proper § 103 rejection for the following reasons. As provided above, at column 4, line 65 to column 5, line 2, the Kurata reference states, "Furthermore, although fluorescent

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lamps are used for directing light onto the cursor to detect the position thereof, a light emitting element such as a light emission diode may be provided at the cursor to detect the position thereof without using any fluorescent lamp." By stating this, the Kurata reference appears to disclose using a light emission diode to direct light onto the cursor in order to detect the physical position of the cursor, as an alternative to using the fluorescent lamps to direct light onto the cursor to detect the physical position thereof. The Kurata reference does not describe, teach, or suggest "a focused beam of light to trace at least part of a perimeter of the scan window", as recited in independent claim 9 as amended.

Further, Applicant's independent claim 13 recites in part:

a scan window illumination device configured to define the scan window with a perimeter, the scan window illumination device comprising a light source configured to generate a focused beam of light to trace at least part of the perimeter.

And, Applicant's independent claim 21 recites in part:

tracing at least a portion of a perimeter of the scan window on the scanable surface using at least one focused beam of light

As such, each and every element of independent claims 9, 13, and 21, is not described, taught, or suggested in the Kurata reference. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the § 103 rejection for the above independent claims 9, 13, and 21, as well as those claims which depend therefrom.

As mentioned above, the Examiner also states, "Kurata further discloses that a light emitting element such as a light emission diode may be provided at the cursors. Therefore, it would have been obvious . . . to provide light emission diodes at cursors 3, 4, 5, and 6 of a conventional position setting apparatus to identify a desired region (scanning window) on platen 2 as shown in figure 1. (Office Action, page 3, paragraph 4).

However, figure 1 of the Kurata reference appears to describe a conventional image position determination apparatus sought to be improved by the position setting apparatus of Kurata. (column 1, lines 23-25 and column 2, lines 9-15). As discussed above, a light emitting diode appears to be used in the apparatus of the

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Kurata reference in order to locate the physical position of a cursor without having to use a fluorescent lamp, but does not describe, teach, or suggest the elements and limitations presented above.

Based on the foregoing, Applicant respectfully submits that the Kurata reference does not support a proper obviousness rejection. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the § 103 rejection for the above independent claims 9, 13, and 21, as well as those claims which depend therefrom.

Allowable Subject Matter

Claims 11, 12, 19 and 20 were objected to as being dependent upon a rejected base claim, but were indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant thanks the Examiner for this indication of allowable subject matter.

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CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney Gregg W. Wisdom at (360) 212-8052 to facilitate prosecution of this matter.

At any time during the pendency of this application, please charge any additional fees or credit overpayment to the Deposit Account No. 08-2025.

CERTIFICATE UNDER 37 CFR §1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS AF Commissioner for Patents, P.O. BOX 1450, Alexandria, VA 22313-1450 on this 23rd day of March, 2006.

Sarah L Reinhard
Name

Sarah L Reinhard
Signature

Respectfully Submitted,
Robert Sesek, et al.

By their Representatives,
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By: [Signature]
Jeffery L. Cameron
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Date: 3/23/06

Exhibit D

Receipt is hereby acknowledged for the following in the
United States Patent and Trademark Office

In Re: Application of: Robert G. Ssek, et al.
Title: OPTICAL SCANNING DEVICE HAVING
SELECTABLE, IDENTIFIABLE SCAN WINDOW

Serial No.: 09/938,893 Filed: August 24, 2001

CONTENTS: return postcard(s) (2); transmittal sheet (1 pg.)
and duplicate; and Amendment and Response Under 37 CFR
§1.116 (12 pgs).

JLC/SLR
Mailed: March 23, 2006

Docket: 10010609-1
Due: April 30, 2006

